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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

U.S. Serial No. 10/607,744

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 ) Dated: November 7, 2005  
 )  
 ) Georgann S. Grunebach  
 ) Registration No. 33,179

Applicants: Soule et al.

Title: Chassis Spring Finger Tortuous  
Path with Improved Manufacturability

Filed: June 27, 2003

TC/AU: 2831

Examiner: Ngo, Hung V

Docket No.: PD-203022

Mail Stop AF  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

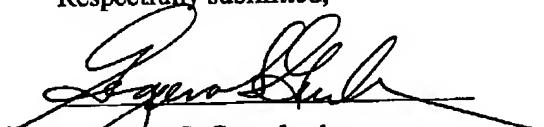
The applicants request review of the final rejection in the above-identified application.  
 No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.

I am the attorney or agent of record.

Respectfully submitted,



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 Attorney for Applicants

Dated: November 7, 2005

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**REASONING ACCOMPANYING A PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The applicants file herewith a Notice of Appeal and respectfully requests review of this case prior to filing an appeal brief. As addressed below, the rejections on the record omit essential elements required for a *prima facie* rejection. Thus, the applicants respectfully request allowance of the claims or the reopening of prosecution.

## **The Rejections Under 35 U.S.C. § 112**

The first Office action, dated April 20, 2005, rejected claims 2 and 5-8 as being indefinite. With regard to claims 2 and 5, this rejection pertained to the numbering of the bends recited in the claims and how those bends correspond to the numbered bends as described in the specification. With regard to claims 7 and 8, the unclarity appeared to be related to the magnitude of angle of at the pre-step portion and the hem. The first Office action also indicated that claims 5-8 were not considered because of 112 problems.

In response to the rejections, the applicants amended claims 5, 6, and 8 to revise the numbering used to refer to the claimed bends. The applicants argued that while the specification and the drawings differ on the numerical indicators (e.g., first, second, etc.) used to designate various bends, the differences in these indicators are immaterial as the claims clearly indicate the structural location of the bends to which the claims refer. The indicators used in the specification were selected to differentiate between bends addressed in the description for convenience so as to refrain from constantly reciting the physical structures

between which a particular bend lies. Based on this reasoning, the applicants respectfully requested withdrawal of the rejection.

With regard to claim 7, the applicants argued that the second bend in claim 7 refers to the bend lying between the chassis cover step portion (e.g., reference numeral 39 in FIG. 9) and the chassis cover pre-step portion (e.g., reference numeral 24 in FIG. 9). The bend lying between these two structures (e.g., the bend 34 shown in FIG. 9) is about 90 degrees. Based on this reasoning, the applicants respectfully requested withdrawal of the rejection.

With regard to the failure of the Office action to consider claim 5-8, the applicants argued that the claims as originally presented were sufficiently clear so as to be subjected to scrutiny under §§ 102 and 103. In particular, the applicants argued that while the Office action objected to the claims as reciting numbered bends that are not sequential, the non-sequential nature of the bend numbering was not fatal to the claims because antecedent basis was maintained within the numbering recited in the claim. For example, a particular bend was first referred to as "a third bend" and was subsequently referred to in the claims as "the third bend." By following the antecedent basis rules of claim construction, these claims were clear – even though they skipped numerical indicators in referring to the bends. For these reasons was respectfully submitted that these claims could and should have been examined over the prior art. The applicants also stated that because these claims were clear and could have been examined over the prior art, any prior art rejection to these claims in a subsequent Office action should not be made final so as to give the applicants a full and fair opportunity to respond to any art rejections that could and should have been made in the April 20, 2005, Office action.

The final Office action merely repeats the rejections made in the first Office action. Again, the Office action focuses on the numbering of the bends and the correspondence between the numbering of the bends in the specification and the claims. It is respectfully submitted that the claims are not unclear because each of the numbered bends in the claims recites structural limitations between which the bends lie. Thus, regardless of the bend numbering used in the specification and the claims, the locations of the bends is clearly defined. It is also respectfully submitted that claims 5-8 are clear and should have been subjected to scrutiny under 35 U.S.C. § 102 to give the applicants a full and fair chance to advance the prosecution of the case.

### The Rejections Under 35 U.S.C. § 102

Claim 1 is directed to a chassis assembly and recites, *inter alia*, a chassis cover having a hem assembly and a chassis back. Claim 1 also recites that the hem assembly is mated with the chassis back to provide a tortuous path to any electromagnetic radiation disposed to enter or leave the chassis assembly.

The first Office action, dated April 20, 2005, rejected claim 1 as anticipated by McMiller (US 6,194,653). In particular, the rejection of claim 1, which is on page 3 of the first Office action, contended that McMiller disclosed a chassis cover with a hem assembly and a chassis back. Importantly, the rejection of claim 1 failed to address the mating of the hem assembly and chassis back to form a tortuous path. The rejection failed to propose where McMiller discloses a tortuous path and, in fact, the Office action failed to even contend that McMiller disclosed a tortuous path.

In response to the first Office action, the applicants pointed out the deficiencies of the rejection over McMiller. In particular, the response indicated that the rejection failed to indicate where in McMiller a tortuous path could be found. Further, in an effort to move prosecution forward, the response attached figure 1 of McMiller and noted how the structures of McMiller on which the applicants suspected the examiner was relying failed to form a tortuous path when assembled.

A final Office action was mailed on October 6, 2005, maintaining the rejection of claim 1 over McMiller. In response to the applicants' arguments, the final Office action stated that the invention of McMiller is functioning as claimed. Again, the rejection failed to provide information as to how McMiller discloses the formation of the recited tortuous path.

As the record reflects, on November 4, 2005, a telephone conference was held with Examiner Ngo. Claim 1 was discussed, as was the disclosure of McMiller. No agreement was reached and the applicants are still unsure as to where in McMiller the examiner purports to find the recited tortuous path. The result of the telephone conference prompted the filing of this Pre-Appeal Brief Request for Review. Nevertheless Examiner Ngo is thanked for his time to conduct the interview.

It is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). The Office has not provided any evidence or contention of how McMiller discloses

the formation of a tortuous path. Thus, it is respectfully submitted that no *prima facie* case of anticipation has been made.

Reconsideration of the application and allowance thereof are respectfully requested. If there is any matter that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,



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Attorney for Applicants

Dated: November 7, 2005

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